

REMARKS

Claims 1-15 are currently pending in the application. Claims 10-15 have been added.

Claims 1-9 stand rejected over Kara (5,801,944) in view of Bresnan (5,873,073) and File (5,174,493). This rejection is respectfully traversed.

The instant invention as set forth in independent method claim 1 and independent apparatus claim 9 is directed to a processor based postage metering environment where a document 9 (such as a bill) is produced having first and second evidences of postage thereon. The first and second evidences of postage are printed by the postage metering system on the document at locations that are automatically determined by the postage metering system based on user-selected first and second fold configurations. The fold configurations are selected from a plurality of possible fold configurations. This unique capability within a postage metering system provides great flexibility for the user in that many different fold configurations can be used and the postage metering system will dynamically determine where to print the first and second evidences of postage within the document. As discussed in the specification, one advantage of this capability is that a single document can be used to initially convey information as well as to act as a reply mechanism because the first and second evidences of postage will account for the cost of the mailing service for the initial conveyance as well as the reply.

As discussed in the background of the invention of the instant specification, Kara only anticipates printing an indicium in the upper right hand corner of a document as reflected in Figure 16B thereof. Kara does not dynamically determine where to print evidence of postage in a document since the printing location is a fixed parameter. For example, the evidence of postage printing locations of Figures 6, 8, 11, 17, and 18 of the instant specification are neither taught nor suggested by Kara. Furthermore, Kara does not teach or suggest that the automatic determination of a

printing location of evidence of postage by the postage metering system be based on a user-specified fold configuration. It is clear from the Kara reference that it is up to the user to determine how to fold the printed document subsequent to the printing of postage thereon. Thus, in Kara, the predetermined evidence of postage location will dictate the fold subsequently used and not vice versa.

Additionally, Kara does not teach printing two evidences of postage on the same document. This provides an independent basis for the patentability of claims 1 and 9.

Bresnan is even more remote from the claimed invention than Kara because Bresnan is directed to preparing a mailpiece made up of an insert (document which is prepared based on predetermined criteria) that is subsequently placed in an envelope. Bresnan teaches that the envelope has evidence of postage placed thereon and not the prepared document. Accordingly, Bresnan does not teach or suggest printing evidence of postage on a document prepared by a postage metering system, let alone printing two evidences of postage on the document.

Furthermore, while Bresnan does permit a user to select the type of fold configuration desired for the inserts, this information is never used by a postage metering system to automatically determine where to print two evidences of postage on the inserts.

Regarding File, the Examiner uses it to teach that different type folds are used for reply envelopes. The Applicants agree with this position. However, File does nothing to correct the deficiencies of the Kara and Bresnan references discussed above. That is, File does not teach or suggest a postage metering system that permits a user to specify first and second fold configurations which information is respectively used to automatically determine the printing locations of first and second evidences of postage on a document produced by the postage metering system.

The Examiner also suggests that there are mailers that include reply documents as part of a single document and which include first and second evidences of postage on the single document. Applicants respectfully request the

Examiner to produce a reference showing such a single document since they are not aware of such reference. Furthermore, even if such a reference is produced it would not be relevant unless it shows the real time creation of such a document based on user-specified fold configuration inputs.

In view of the above, it is submitted that the references, either alone or in combination, do not teach or suggest the invention of claims 1 and 9. Further since claims 2-8 depend from claim 1 they are also considered patentable based on that dependency as well as for the elements specifically recited therein.

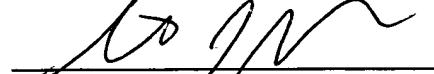
It is further submitted that, while the Examiner has not produced any references teaching the claimed invention, he takes the position that the invention is obvious. However, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must be able to point to something in the prior art that suggests in some way a modification of a particular reference or a combination with another reference to arrive at the claimed invention. Absent such a showing in the prior art, the Examiner has impermissibly used the Applicants' teaching to hunt through the prior art for the claimed elements and combine them as claimed. Such hindsight use of the Applicants' disclosure is improper. *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Claims 10-15 have been added to provide the Applicants with a full scope of patent protection and have not been added for reasons related to patentability. Claims 10-15 depend from claim 9 and are considered to be in condition for allowance.

It is submitted that the application stands in condition for allowance. Reconsideration of the rejection is respectfully requested and an early notice of

allowance earnestly solicited. If, however, the Examiner has any questions, please contact the undersigned at the number below.

Respectfully submitted,



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